

REMARKS

Claims 2-26 are pending in the application.

Claims 2-20 have been allowed.

Claim 21 has been rejected.

Claim 22-26 have been objected to.

Claim 21 has been amended as set forth herein.

Claim 1 has been previously cancelled.

Claims 2-26, as amended, remain pending in this application.

Reconsideration of the claims is respectfully requested.

I. CLAIM OBJECTIONS

The Examiner stated that “Claim 21 is objected to because of the following informalities: Claim 21 status should be changed to – previously amended— since there was no change made to Claim 21 with status listed as ‘currently amended.’ Appropriate correction is required.” (June 2, 2008 Office Action, Page 2, Paragraph 1).

Claim 21 was supposed to have been amended (but was not amended) in the previous Amendment of February 11, 2008. That is why Claim 21 was marked as “currently amended” in the Amendment of February 11, 2008. Claim 21 has been amended in the present Amendment. That is why its status is now correctly stated as “currently amended.” The Applicant respectfully submits that the objection to Claim 21 has been overcome.

II. CLAIM REJECTIONS -- 35 U.S.C. § 102

Claim 21 was rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,058,032 to Iacono et al. In response, the Applicant has amended Claim 21 to add claim limitations to Claim 21.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131, p. 2100-76 (8th ed., rev. 4, October 2005) (*citing In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir.1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. *Id.* (*citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)).

Claim 21 has been amended to add the limitations of original Claim 2. Accordingly, amended Claim 21 is now believed to be allowable over the cited prior art. Therefore, the Applicant respectfully requests that the Examiner withdraw the § 102 anticipation rejection of Claim 21.

On August 4, 2008 the Applicant filed an Amendment Under 37 C.F.R. § 1.116 and requested an Advisory Action. The Examiner issued an Advisory Action that was mailed on September 9, 2008. The Advisory Action stated that the Applicant's Amendment Under 37 C.F.R. § 1.116 would not be entered.

The Advisory Action stated that a proposed amendment to Claim 21 would not make Claim 21 allowable because “the feature is found in admitted prior art paragraph 0056-0059 & fig. 8 of the original disclosure.” (September 9, 2008 Advisory Action, Page 2, Lines 1-3).

The Applicant respectfully traverses these assertions for the reasons set forth below

First, Paragraphs [0056] to [0059] of the original disclosure are not “admitted prior art.” These paragraphs describe features of the invention.

Second, although Figure 8 and corresponding Paragraphs [0049] – [0051] of the specification describe prior art features, Figure 8 does not disclose or suggest the elements of amended Claim 21. Specifically, Figure 8 does not disclose or suggest “iteratively applying at least one set reduction constraint” to a transport format combination set. Figure 8 does not disclose or suggest “deleting TFC candidates from said transport formation combination set that do not meet said at least one set reduction constraint.”

The Applicant respectfully submits that Claim 21, as amended, now contains allowable subject matter. The Applicant respectfully requests that Claim 21, as amended, be passed to allowance.

III. ALLOWABLE SUBJECT MATTER

Claims 2-20 have been allowed over the prior art.

Claims 22-26 have been objected to as being dependent upon a rejected base claim (Claim 21), but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In view of the Applicant's amendment of Claim 21, the Applicant respectfully submits that Claims 22-26 are now allowable.

IV. CONCLUSION

For the foregoing reasons, the Applicant respectfully requests full allowance of all pending claims and that this patent application be passed to allowance.

The Applicant's attorney has made the amendments and arguments set forth above in order to place this patent application in condition for allowance. In the alternative, the Applicant's attorney has made the amendments and arguments to properly frame the issues for appeal. The Applicant makes no admission concerning any now moot rejection or objection, and affirmatively deny any position, statement or averment of the Examiner that was not specifically addressed herein.

SUMMARY


As a result of the foregoing, the Applicant respectfully asserts that the claims in the patent application are in condition for allowance, and respectfully requests an early allowance of such claims. If any issues arise, or if the Examiner has any suggestions for expediting allowance of this patent application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at ***wmunck@munckcarter.com***.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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